

REMARKS

Claims 71 and 72 have been cancelled. Claims 1-5, 7-23, 28, 41, 42, 44-47, 49-51, 53-70, 73 and 74 are pending in the application. Reconsideration is respectfully requested in light of the following remarks.

Section 102(b) Rejection:

The Office Action rejected claims 1-4, 7-11, 13-15, 22, 23, 28, 41-42, 50, 55-56, 58-62, 69-70 and 74 under 35 U.S.C. § 102(b) as being anticipated by Theimer (U.S. Patent 5,627,517). As set forth in more detail below, Applicant respectfully traverses the rejection as to the currently pending claims.

With respect to claim 1, the cited art fails to teach or suggest a method for shipping goods that involves: a central server receiving via a network a request to ship an item from an origination to a final destination; the central server searching a database for a most inexpensive routing, where the most inexpensive routing includes using two or more different shipping companies and one or more intermediate destinations; the central server generating a data file comprising at least the following: intermediate destination information identifying the one or more intermediate destinations, and final destination information identifying the final destination; the central server transferring the data file over a network; and storing the data file in a memory device that accompanies the item.

The Office Action states that the central server of claim 1 is anticipated by the “large-scale transceiver” 106 of FIG. 3 of Theimer. Office Action, p. 3. In doing so, the Office Action relies on a single one of the many dictionary definitions of “server.” The Office Action states that: “server, as defined by Merriam-Webster [sic] Dictionary, is one that serves legal processes upon another. Therefore, transceiver can broadly read as a central server as receiving and transmitting data processes.” Office Action, p. 3, footnote 1. Applicant strongly traverses the application of this definition to the term “server” in Applicant’s claims. There is no doubt that one of ordinary skill in the art would not

interpret the term “server” in Applicant’s claims to mean “one that serves legal processes upon another”. Nor would one of ordinary skill in the art consider the term “server” in Applicant’s claims to read on the “large-scale transceiver” of Theimer.

Applicant notes that while it is proper during examination to give claim terms their broadest meaning, this is limited to meanings that are “consistent with the specification” and “consistent with the interpretation that those skilled in the art would reach.” See MPEP § 2111, citing *In re Prater*, 415 F.2d 1393, 1404-5, 162 USPQ 541, 550-51 (CCPA 1969) and *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999). “Because words often have multiple dictionary definitions, some having no relation to the claimed invention, the intrinsic record must always be consulted to identify which of the different possible dictionary meanings of the claim terms in issue is most consistent with the use of the words by the inventor.” *Texas Digital Systems, Inc. v. Telegenix*, 308 F.3d 1193, 1203, 64 U.S.P.Q.2d 1812 (Fed. Cir. 2002). The specification may use a term in a way that is clearly inconsistent with the ordinary meaning of that term as reflected in a dictionary definition. “In such a case, the inconsistent dictionary definition must be rejected.” *Id.* at 1204, citing *Renishaw PLC v. Marposs Societa’ per Azioni*, 158 F.3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed.Cir.1998) (“[A] common meaning, such as one expressed in a relevant dictionary, that flies in the face of the patent disclosure is undeserving of fealty”); and *Liebscher v. Boothroyd*, 46 C.C.P.A. 701, 258 F.2d 948, 951, 119 USPQ 133, 135 (1958) (“Indiscriminate reliance on definitions found in dictionaries can often produce absurd results”). Applicant asserts that defining “server”, as used in claim 1, as “one who serves legal processes upon another” is clearly inconsistent with the specification and with the meaning that one of ordinary skill in the art would give the term. Applicant further asserts that using any reasonable interpretation of “server” that is consistent with the specification and the meaning that one of ordinary skill in the art would give the term, the claim element “server” would not be anticipated or suggested by a mere transceiver. Accordingly, claim 1 is patentable over the cited art.

Additionally, the cited art neither teaches nor suggests that the “large-scale transceiver” of FIG. 3 of Theimer performs the functions recited as being performed by a “central server” in claim 1, nor does the Office Action provide any suggestion as to how or why the “large-scale transceiver” would be so modified. For example, the Examiner cites col. 4, lines 1-7 of Theimer as teaching the central server receiving via a network a request to ship an item from an origination to a final destination. However, this portion of Theimer states: “Upon entering the distribution system, the packet 10, with its associated tag 100, can be queried at an input transceiver I. The input transceiver I broadcasts to the tag 100 a query message which solicits, in the microprocessor in tag 100, a response to the input transceiver I in which the tag 100 of package 10 essentially says, ‘I want to go to [for example] destination node D.’” No relationship between the input transceiver I of FIG. 1 and the large-scale transceiver 106 of FIG. 3 is provided, nor is there any suggestion to modify the large-scale transceiver to perform the functions of input transceiver I. Nor does the cited passage of Thiemer anticipate or suggest a central server receiving via a network a request to ship an item from an origination to a final destination, as recited in claim 1.

Thus, no portion of Theimer or any other cited art suggests modifying the large-scale transceiver of FIG. 3 (or any other one of the various components cited as anticipating a “central server”) to include a central server as recited in pending claim 1.

Furthermore, Theimer explicitly teaches away from any modifications that would centralize control of its distribution system: “The general principle behind [Theimer] is that each package is ultimately responsible for its own fate in the distribution system, as opposed to a centralized system in which each package being tracked is a passive object under the control of a central control system.” Theimer, col. 3, lines 47-51, emphasis added.

Further with respect to claim 1, the cited art fails to teach or suggest a central server searching a database for a most inexpensive routing, where the most inexpensive routing includes using two or more different shipping companies. Theimer recites that a

tag may have access to “information about cost alternatives, particularly among competing transport services.” Theimer, col. 9, lines 44-45. Applicant notes that many cost alternatives and competing transport services exist within a single shipping company. For example, a shipping company may offer both next-day service, which may have a significant cost and use airplanes to transport packages, and standard service, which may have insignificant cost and use trucks to transport packages. Furthermore, while different cost alternatives may be selected for different packages, a package is generally only shipped using a single one of these cost alternatives. Thus, Theimer neither teaches nor suggests shipping one package via a route that uses multiple different shipping companies. Accordingly, the cited art fails to teach or suggest claim 1.

Claims 2-4, 7-11, 13-15, 22, 23, 28, 41-42, 50, 55-56, 58-62, 69-70 and 74 are patentable over the cited art for reasons similar to the foregoing reasons provided above with respect to claim 1.

Additionally with respect to claims 28, the cited art fails to teach or suggest updating the data file on the central server to reflect arrival of the item at one or more of the intermediate destinations. The portion of Theimer cited in the rejection of this claim recites: “[If] the various nodes throughout the country are each provided with transceivers that merely broadcast the local zip code, microprocessor 200 can be programmed to, for example, transmit a distress signal if, after three days, the first number of the local zip code is not 9, or if the zip code it is currently receiving does not begin with 943. A system could be provided which causes the tag 100 to transmit its last-received zip code or destination code with its distress signal, along with the time of last receipt of any such broadcast signal.” This portion of Theimer clearly fails to teach or suggest updating a data file on a central server. Claim 56 is patentable for similar reasons.

Section 103(a) Rejections:

The Office Action rejected claims 5, 49 and 57 under 35 U.S.C. § 103(a) as being unpatentable over Theimer. Claims 12, 16, 17, 63-65 and 71-72 were rejected as being

unpatentable over Theimer in view of Ross (U.S. Patent 6,332,098). Claims 18, 20-21 and 66 were rejected as being unpatentable over Theimer in view of Welles (U.S. Patent 5,686,888). Claim 19 was rejected as being unpatentable over Theimer in view of Wortham (U.S. Patent 5,999,091). Claims 44-47, 51, 68 and 73 were rejected as being unpatentable over Theimer in view of Shavit (U.S. Patent 4,799,156). Applicant asserts that these claims are patentable over the cited art for at least the foregoing reasons given above with respect to claim 1.

With respect to claims 5, these claims are additionally patentable over the cited art due to failure of the art to teach or suggest forwarding copies of the data file via the network to one or more predetermined email addresses. The Office Action states that it “would have been obvious to one of ordinary skill in the art to forwarding copies of data file using email since email is the fastest way to communicate.” Office Action, p. 10-11. Applicant cannot find any suggestion in the cited art to forward copies of a data file or that faster communications are desirable, nor can Applicant find any suggestion that email is “the fastest way to communicate.” Thus, the Office Action’s statement impermissibly relies on the level of skill in the art to provide a suggestion to modify Theimer in the absence of any reference that suggests such a modification. “To imbue one of ordinary skill in the art with knowledge of the invention... when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.” *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed.Cir.1983). “To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references... [S]implicity and hindsight are not the proper criteria for resolving the issue of obviousness.” *Ex Parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Int’f 1985). Claim 57 is patentable for similar reasons. The rejection of these claims is not supported by any teaching found in the prior art. Instead, the Examiner has impermissibly applied hindsight speculation to

reject the claims. Even when the Examiner is relying on implicit teachings, “particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.” *In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). Such findings must be support by actual evidence, not just statements by the Examiner. *Id.*

CONCLUSION

Applicant submits the application is in condition for allowance, and notice to that effect is requested.

If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above referenced application from becoming abandoned, Applicant hereby petitions for such extension. If any fees are due, or if any overpayments have been made, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5596-00400/RCK.

Also enclosed herewith are the following items:

- Return Receipt Postcard
- Notice of Change of Address
- Fee Authorization Form authorizing a deposit account debit in the amount of \$ for fees ().
- Other:

Respectfully submitted,



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